

REMARKS

State of the Claims

Initially, it is noted that the Office Action Summary (indicating allowance) is in conflict with the body of Office Action (indicating rejection) regarding claims 1-3, 5, 10-14 and 16-19. Presumably, the claims were accidentally listed on line 5 instead of on line 6 in the Office Action Summary. In the interest of providing a complete reply, Applicant therefore will proceed as if the claims do in fact stand rejected as per the body of the Office Action, without conceding the merits of those rejections.

Claims 4, 6-9, 15 and 20 have been indicated as containing allowable subject matter, but nevertheless stand objected to as depending upon a rejected base claim.

Claims 13 and 14 have been rejected under 35 U.S.C. §112, first paragraph, as lacking sufficient antecedent basis for "wherein individual output media."

Claims 1-3 and 17-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by DeHority (US Patent No. 5,129,639).

Claims 10-12, 14 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ojha (US Patent No. 4,987,447).

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over DeHority in view of Edens, et al. (US Patent No. 6,249,716).

Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ojha in view of Kurogane (US Patent No. 5,126,858).

The Present Claims Distinguish Patentably over the Applied Reference(s)

Claims 4, 6, 9, 15 and 20, indicated in the outstanding Office Action as containing allowable subject matter, have been placed in independent format and are now deemed in condition for allowance, along with claims 7 and 8 that now depend from claim 6. The Examiner's recognition of the allowable nature of these claims is greatly appreciated. However, Applicant points out that the claims taken as a whole define inventive aspects from the prior art. It is noted in particular that one specific aspect does not result in patentable subject matter, but rather the claims when interpreted on the whole define patentable subject matter. Accordingly, Applicant believes the Examiner's statements regarding the reasons for finding patentable subject matter are not the only reasons the claims distinguish patentably

over the art. In short, while the Applicant agrees that the claims are allowable, the Applicant does not concede that they are only allowable for the precise reasons stated by the Examiner nor are the respective features identified absolutely necessary for patentability.

The rejection of claim 1 based upon DeHority is traversed, and currently amended claim 1 is submitted as allowable. Notably, DeHority fails to disclose applying a second finishing operation such that a mark indicative of the first finishing instruction is placed anywhere in the output print job. Rather, the focus of DeHority is to detect a mismatch in the finishing operations, and upon detecting such a mismatch, the options are merely to correct the finishing operation to the closed match or take no action depending on a users selection. Nowhere does DeHority disclose that the second finishing operation (i.e., the so called closest matching operation) is carried out in the manner claimed, i.e., such that a mark indicative of the first finishing instruction is placed anywhere in the output print job. Accordingly, it is submitted that claim 1 is allowable over the art.

Currently amended claims 10 is also submitted as allowable. Claim 10 calls for "receiving the print job, said print job including one or more desired finishing instructions and job content distinct from the finishing instructions, said job content being that portion of the print job which is to be printed on one or more individual sheets of output media; generating a marker representing at least one of the desired finishing instructions; and, placing the marker at a selected location relative to the print job, said marker being placed on the same output media as the job content."

Claim 10 now provides suitable antecedent basis for dependent claims 13 and 14. Further, claim 10 defines patentably over the art. Notably, the desired finishing instructions and the job content are distinct from one another yet both the mark representing the finishing instruction and the job content are placed on the same output media. Ojha only discloses that the set-up instructions are output to a control sheet that does not have other job content output thereto. That is to say, the job content and set-up instructions are output to separate media. Accordingly, it is submitted that claim 10, and claims 11-14 and 16 that depend therefrom, are allowable over the art.

It is also submitted that currently amended claim 17 is allowable. Again, DeHority fails to disclose that a selected compatible finishing instruction is supplied to a finishing element such that the finishing operation carried out thereby

includes marking the print job with the desired finishing instruction. Rather, DeHority merely determines if a mismatch exists and either supplies a corrected best match or provides a "no go" in response to a users selected strategy. Applicant can find nowhere that DeHority discloses marking the print job with the desired finishing instruction. Accordingly, it is submitted that claim 17, and claims 18 and 19 that depend therefrom, are allowable over the art.

CONCLUSION

For at least the reasons set forth above, it is submitted that the remaining claims as they now stand distinguish patentably over the art. Accordingly, an early indication of allowance is requested.

Telephone Interview

In the interests of advancing this application to issue and compact prosecution, the Applicant invites the Examiner to telephone the undersigned for an interview prior to substantive action in response to this paper should the Examiner feel that such an interview would be productive.

Respectfully submitted,

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